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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/889,661	07/08/97	WINSLOW	C 1791-CON

QM31/0721

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EXAMINER	
WOO, J	
ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 07/21/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary	Application No. 08/889,661	Applicant(s) Winslow et al
	Examiner Julian W. Woo	Group Art Unit 3731

☒ Responsive to communication(s) filed on *7-8-97* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-21* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) *6-11* is/are allowed.

☒ Claim(s) *1-4, 12-17, and 19-21* is/are rejected.

☒ Claim(s) *5 and 18* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference

inherently discloses that element or limitation. See, for example, Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

2. Claims 1-4, 12, 13, 15, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison (3,486,505). With respect to claims 1, Morrison discloses a method for performing a surgical spinal procedure with a retractor that has an elongate member, an opening to receive instrumentation, and a distal end portion configured for insertion into an intervertebral space between adjacent opposed vertebrae. Morrison in figures 1 and 2 discloses that the adjacent vertebrae are distracted by at least partially inserting the distal end of the retractor within the intervertebral space and that a surgical spinal procedure is subsequently performed. With respect to claim 2, Morrison's retractor has two spaced apart arms having first and second supporting surfaces. The step of distracting includes inserting the retractor arms within the intervertebral space whereby the first and second supporting surfaces of each retractor arm respectively engage the adjacent opposed vertebrae. With respect to claim 3, the surgical procedure performed by Morrison's retractor includes the introduction of a sliding block as the instrumentation through the opening of the retractor. The sliding block is used to perform the surgical procedure. With respect to claim 4, Morrison discloses a surgical procedure where a bone graft or a fusion implant is introduced through the opening in the retractor and between the distracted vertebrae. With respect to claims 12 and 15, Morrison discloses a retractor instrument with an elongated member having proximal and distal end portions and defining a channel or a longitudinal passageway for reception of surgical instrumentation. The distal end portion has first

and second retractor arms extending in a general longitudinal direction. Each retractor arm has first and second support surfaces for engaging opposed adjacent tissue portions, and the support surfaces define a dimension sufficient to distract the opposed tissue portions upon insertion thereof. The distraction distance between the first and second vertebra supporting surfaces can easily be predetermined. With respect to claim 13, figure 5 of Morrison discloses that the first and second supporting surfaces of each retractor arm are substantially planar. With respect to claim 17, the distal edges of the first and second supporting surfaces of each retractor arm in Morrison's retractor are in general parallel relation. With respect to claim 19, the elongate body of Morrison's retractor includes a longitudinal opening in an intermediate wall portion between the lateral guides and the handle.

3. Claims 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuslich et al (5,489,308). With respect to claim 20, figures 12 and 13 of Kuslich et al. disclose a spinal implant that can tap an internal thread in a bore defined in bony tissue. The implant is an elongated frame with a longitudinal axis, a tapping head; and at least one conveyance channel, having a directional component transverse to the longitudinal axis, for collecting bone material removed during the tapping procedure. With respect to claim 21, the conveyance channel in Kuslich's implant is a helical groove.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA) 1975. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

5. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison in view of Michelson (5,484,437). Morrison discloses the invention substantially as claimed. However, Morrison does not disclose tapered end portions at the distal ends of the retractor arms. Michelson teaches in figure 11A tapered or sharpened teeth at the distal end of a hollow sleeve for engagement with vertebrae. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Michelson, to taper or sharpen the distal ends of the retractor arms of Morrison's retractor. Such a modification would facilitate engagement or penetration of the arms with surface of the vertebral bone or ease insertion of the arms into the intervertebral space.

Allowable Subject Matter

6. Claims 5 and 18 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

7. Claims 6-11 are allowed.

8. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huene (3,867,932) teaches an elongated instrument for inserting rigid shafts into fractured bone. It has a pair of sharpened prongs extending from the distal end of an elongate body.

10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (703) 308-0421. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Buiz, can be reached at (703) 308-0871.

General inquiries relating to the status of this application should be directed to the Group receptionist at (703)308-0858. The FAX number is (703)305-3590.

Julian W. Woo

Patent Examiner

July 16, 1998

MICHAEL BUIZ
SUPERVISORY PATENT EXAMINER
GROUP 3300

7/16/98